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09/839,433

04/20/2001

Claude Jarkac Jensen

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1737

21999

7590

10/20/2005

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EXAMINER

GOLLAMUDI, SHARMILA S

ART UNIT

PAPER NUMBER

1616

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/839,433

Applicant(s)

JENSEN ET AL.

Examiner

Sharmila S. Gollamudi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 7/25/05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,7,8,11,12,22 and 27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,7,8,11,12,22 and 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

Receipt of Amendments/Remarks and the Terminal Disclaimer received July 25, 2005 is acknowledged. Claims 1, 7-8, 11-12, 22, and 27 are pending in this application. Claims 2-6, 9-10, 13-21, 23-26, and 28-30 stand cancelled.

#### ***Applicant's Reply to the Request for Information (Rule 1.105)***

Applicant has stated on record that Morinda Inc. released the lip balm in May 26, 2000 and thus does not constitute prior art under 102. Applicant has indicated that examiner has erroneously stated that the lip balm was introduced in 1999. The applicant is willing to provide evidence that the lip balm was introduced in 2000 and not 1999.

The examiner points out that the lip balm might still constitutes prior art under 102(a) and thus the examiner again requests that applicant submit the date in which it was first sold.

#### ***Claim Rejections - 35 USC § 112***

**The rejection of claim 27 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn in view of the amendment of 7/25/05.**

#### ***Claim Rejections - 35 USC § 102***

**The rejection of claims 1, 7-8, and 27 under 35 U.S.C. 102(e) as being anticipated by Jensen et al (6,589,514) is withdrawn in view of the amendments of 7/25/05. It is noted that applicant's assertion that an affidavit "will be provided" does not overcome the rejection.**

**New Rejections Necessitated by the Amendment of 7/25/05**

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 7-8, 11-12, 12, 22, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jensen et al (6,589,514) in view of Vatter et al (6,224,888).**

Jensen teaches a cosmetic intensive repair serum with *Morinda citrifolia*. The composition is an effective treatment for the skin and wrinkles. The composition also moisturizes, soothes, and heals the surface of the skin. See column 2, lines 10-15. Jensen teaches the use of the oil and the fruit juice. See column 5, lines 10-15. Jensen teaches the benefit of *Morinda citrifolia* is its ability to isolate and produce Xeronine, a relatively small alkaloid physiologically active within the body. Xeronine occurs in practically all healthy cells of plants, animals and microorganisms. Even though *Morinda citrifolia* has a negligible amount of free xeronine, it contains appreciable amounts of the precursor of xeronine, called Proxeronine. See column 6, lines 60-65. Jensen teaches vehicles other than water, including liquid or **solid emollients**, solvents, humectants, and powders. See column 9, lines 1-10. Emollients including esters, fatty acids, polyols, and hydrocarbons are utilized in the amount of **0.5-50%** and preferably 5-30%. See column 9, lines 40-45. The composition further includes sunscreens such as PABA, octyl methoxycinnamate, benzophenone, etc. See column 9, lines 28-40. Specifically, example 1 teaches a composition contains **30-40% *Morinda citrifolia* juice, 1-5% *Morinda***

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*citrifolia* oil, 1-5% cetyl alcohol, 5-10% octyl methoxycinnamate, and 0-1% fragrances, among other components. Note that the recitation “lip treatment” is not given patentable weight since it does not impart a structural limitation on the claims.

Although Jensen suggests the use of solid emollients, Jensen does not teach the instant hydrocarbon ozokerite.

Vatter teaches a cosmetic composition including skin care products that treat and care for the skin, i.e. moisturize or improve the condition of the skin. See column 2, lines 20-25. Further, Vatter teaches utilizing a “solidifying agent” that solidifies liquid base materials to be used in a cosmetic composition. This solidifying refers to the physical and/or chemical alteration of the liquid base material so as to form a solid or semi-solid at ambient conditions, i.e., to form a final composition which has a stable physical structure and is deposited on the skin during normal use conditions. The selection of the particular solidifying agent for use in the cosmetic compositions will depend upon the particular type of composition desired, i.e., gel or wax-based, the desired rheology, the liquid base material used and the other materials to be used in the composition. The solidifying agent is preferably used in an amount from about 3% to about 20%. Solidifying agents includes ceresin, ozokerite, white beeswax, synthetic waxes, and mixtures thereof. The waxy materials may also serve as emollients. See column 8, lines 10-45. Additionally Vatter teaches an emollient as essential to the compositions. The emollient component aids in the application and adhesion of the composition to the skin and most importantly provides occlusive moisturization. Suitable oils include esters, triglycerides, hydrocarbons and silicones are used in the amount of 5% to about 90% and most preferably from about 70% to about 90% of the

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emollient component. Petrolatum is specifically taught. See column 5, lines 20-25, column 6, line 9, and column 6, lines 55-60.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Jensen et al and Vatter et al and utilize the instant hydrocarbon. One would have been motivated to do so with the expectation of success since Jensen suggests the use of solid emollients in cosmetic vehicle and further suggests the use of hydrocarbons and Vatter teaches the use of wax hydrocarbon agents not only serve as emollients but also serve to change the rheology of the cosmetic composition to provide for the desired look of the cosmetic composition, i.e. a solid or semi-solid cosmetic composition. Therefore, it would have prima facie obvious to utilize the instant ozokerite in the cosmetic composition of Jensen for its dual purpose of serving as an emollient and its ability to change the physical structure of the composition to yield a desired structure (semi-solid or solid). Moreover, it would have been obvious to further utilize petrolatum in the composition for the advantages taught by Vatter which include providing adhesion of the composition to the skin and provides occlusive moisturization. Lastly, a skilled artisan would have expected success by the instant combination since both references are in the same field of endeavor, i.e. skin care products used to moisturize and care for the skin.

#### ***Response to Arguments***

Applicant argues that US '514 was derived by the inventor of the instant application and thus US '514 is not derived "by another".

Applicant's arguments filed 7/25/05 have been fully considered but they are not persuasive. The examiner points out that US '514 still applies as prior art under 103(c) and if

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applicant attempts to excludes the reference based on common ownership, the applicant must submit the required stated. See MPEP 706.02 (I).

**Claims 1, 7-8, 11-12, 22, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tahitian Noni Products (<http://www.noni-now.com>, copyright 1998-2003) in view of JP2000-095663 to Kondo et al in further view of Vatter et al (6,224,888).**

Tahitian Noni discloses that noni (*Morinda citrifolia*) products combine the benefits of Tahitian noni juice and Tahitian noni oil that nourishes the skin at the cellular level. The cite states that the noni juice delivers soothing and renewing benefits to the skin and the oil contains linoleic acid and essential fatty acids to nourish the skin and dry spots (Note Tahitian Noni essential oil). Lastly, the reference teaches the combination of the juice and oil in Tahitian Noni Skin Supplement and Body Balance Cream. It should be noted that linoleic acid and xeronine are inherent components of *Morinda citrifolia* extract.

The reference does specify percentages of the oil and juice in the topical formulation. Further the reference does not teach the use of instant ozokerite in the composition.

JP teaches a plant extract such as *Morinda citrifolia* for external use. These plant extracts have various properties such as skin whitening abilities, antioxidants effects, and antimicrobial effects, which make them effective for external use. See abstract. The plant extract is utilized in the amount of 0.0005-5% and JP discloses the use of instant *Morinda citrifolia* in the amount of 4.8%. Note Table 2 and page 4 of the translation. The plant extract is extracted from the branch, trunk, bark, bloom, fruit (contains the juice), roots, or other dry matters. The fruit is exemplified. Note that the fruit contains the juice and the seed, which contains the oil. See page 3. The

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external applications taught are milky lotion, cream, a pack, foundation, **lipstick**, shampoo, and conditioner and in the form of a liquid, salve, gel, etc. See page 2 and examples. Kondo et al teach additives such as lower alcohols, polyhydric alcohols, oily components (paraffin, squalene, cetyl alcohol), antioxidants, surfactants, thickeners, astringents, UV absorbents (octyl methoxycinnamate), vitamins, etc. in the cosmetic compositions. See examples and page 4. Examples teach the squalene in the amount of 5% and octyl methoxycinnamate in the amount of 5%. It should be noted that linoleic acid and xeronine are inherent components of *Morinda citrifolia* extract.

Vatter teaches a cosmetic composition including skin care products that treat and care for the skin, i.e. moisturize or improve the condition of the skin. See column 2, lines 20-25. Further, Vatter teaches utilizing a “solidifying agent” that solidifies liquid base materials to be used in a cosmetic composition. This solidifying refers to the physical and/or chemical alteration of the liquid base material so as to form a solid or semi-solid at ambient conditions, i.e., to form a final composition which has a stable physical structure and is deposited on the skin during normal use conditions. The selection of the particular solidifying agent for use in the cosmetic compositions will depend upon the particular type of composition desired, i.e., gel or wax-based, the desired rheology, the liquid base material used and the other materials to be used in the composition. The solidifying agent is preferably used in an amount from about 3% to about 20%. Solidifying agents includes ceresin, **ozokerite**, **white beeswax**, synthetic waxes, and **mixtures thereof**. The waxy materials may also serve as emollients. See column 8, lines 10-45. Additionally Vatter teaches an emollient as essential to the compositions. The emollient component aids in the application and adhesion of the composition to the skin and most importantly provides occlusive



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moisturization. Suitable oils include esters, triglycerides, hydrocarbons and silicones are used in the amount of 5% to about 90% and most preferably from about 70% to about 90% of the emollient component. Petrolatum is specifically taught. See column 5, lines 20-25, column 6, line 9, and column 6, lines 55-60.

Firstly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to look to the teaching of Kondo et al and utilize the instant range of the *Morinda citrifolia* extracts. One would have been motivated to do so since Kondo et al teach cosmetics such as face cream containing *Morinda citrifolia* in the instant range. Further, Kondo teaches the medicinal extract is obtained from any part of the plant, i.e. from the fruit or seed. Thus, one would have been motivated to utilize the instant range of both the oil and juice with the expectation of similar results. Moreover, it should be noted that although the Noni products fail to disclose the amount of the *Morinda citrifolia* juice and oil, the mere difference in concentration as the sole criteria for patentability for subject matter encompassed by the prior art is not supported **in the absence of unexpected data**. See MPEP 2144.05. Furthermore, since the Noni lip balm contains the same critical ingredients for the same functional purpose and absent the applicant's demonstration of the unexpectedness to the concentration of the components, it is deemed that concentration is a manipulatable parameter known to those skilled in the art at the time the invention was made.

Secondly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further look at the teachings of Vatter et al and utilize the instant ozokerite. One would have been motivated to do so with the expectation of success since Jensen suggests the use of solid emollients in cosmetic vehicle and further suggests the use of

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hydrocarbons and Vatter teaches the use of wax hydrocarbon agents not only serve as emollients but also serve to change the rheology of the cosmetic composition to provide for the desired look of the cosmetic composition, i.e. a solid or semi-solid cosmetic composition. Therefore, it would have prima facie obvious to utilize the instant ozokerite in the cosmetic composition of Jensen for its dual purpose of serving as an emollient and its ability to change the physical structure of the composition to yield a desired structure (semi-solid or solid cosmetic). Moreover, it would have been obvious to further utilize petrolatum in the composition for the advantages taught by Vatter which include providing adhesion of the composition to the skin and provides occlusive moisturization. Lastly, a skilled artisan would have expected success by the instant combination since both references are in the same field of endeavor, i.e. skin care products used to moisturize and care for the skin.

### ***Response to Arguments***

Applicant argues that the examiner has applied the wrong date for the Noni Products and that the products in which the examiner relies on were added to the website on 4/20/04. The applicant states that the applicant will provide an affidavit.

Applicant's arguments filed 7/25/05 have been fully considered but they are not persuasive. The examiner points out that Noni Now products are still considered prior art until applicant provides convincing evidence substantiating applicant's assertion that the products were added to the website on 4/20/04. It should be noted that applicant's arguments alone cannot take the place of evidence.

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**Claims 1, 7-8, 11-12, 22, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morinda Inc. Lip Balm in view of Fisher (Living Better, vol. 1 (5) 1998) in further view of JP2000-095663 to Kondo et al in further view of Vatter et al (6,224,888).**

Applicant's statement on record on 7/25/05 provides the composition of the lip balm sold by Morinda Inc. (instant assignee) on May 26, 2000. Applicant states that lip balm contains noni seed oil, petrolatum, ozokerite, beeswax, octyl methoxycinnamate, sorbitan oleate, benzophenone -3, beeswax, paraffin, canola oil, shea butter, propylparaben, tocopheryl acetate (vitamin E acetate), sweet almond oil, macadamia temifolia seed oil, kukui nut oil, fragrance, butylated hydroxyanisole, propyl gallate, and citric acid. See applicant's statement of record 7/25/05. It should be noted that linoleic acid and xeronine are inherent components of *Morinda citrifolia* extract.

The lip balm does not have the instantly claimed noni fruit juice. Further, the concentrations of the components are not specified.

Fisher teaches that the French Polynesians have used noni (*Morinda citrifolia*) for over 2000 years for it healing benefits. See page 1. Further, Fisher teaches French Polynesians traditionally use the noni fruit juice. The various uses of noni include healing skin problems such as abrasions, wounds, boils, etc. See page 2.

JP teaches a plant extract such as *Morinda citrifolia* for external use. These plant extracts have various properties such as skin whitening abilities, antioxidants effects, and antimicrobial effects, which make them effective for external use. See abstract. The plant extract is utilized in the amount of 0.0005-5% and JP discloses the use of instant *Morinda citrifolia* in the amount of 4.8%. Note Table 2 and page 4 of the translation. The plant extract is extracted from the branch,

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trunk, bark, bloom, fruit (contains the juice), roots, or other dry matters. The fruit is exemplified. Note that the fruit contains the juice and the seed, which contains the oil. See page 3. The external applications taught are milky lotion, cream, a pack, foundation, **lipstick**, shampoo, and conditioner and in the form of a liquid, salve, gel, etc. See page 2 and examples. Kondo et al teach additives such as lower alcohols, polyhydric alcohols, oily components (paraffin, squalene, cetyl alcohol), antioxidants, surfactants, thickeners, astringents, UV absorbents (octyl methoxycinnamate), vitamins, etc. in the cosmetic compositions. See examples and page 4. Examples teach the squalene in the amount of 5% and octyl methoxycinnamate in the amount of 5%.

Vatter teaches a cosmetic composition including skin care products that treat and care for the skin, i.e. moisturize or improve the condition of the skin. See column 2, lines 20-25. Further, Vatter teaches utilizing a "solidifying agent" that solidifies liquid base materials to be used in a cosmetic composition. This solidifying refers to the physical and/or chemical alteration of the liquid base material so as to form a solid or semi-solid at ambient conditions, i.e., to form a final composition which has a stable physical structure and is deposited on the skin during normal use conditions. The selection of the particular solidifying agent for use in the cosmetic compositions will depend upon the particular type of composition desired, i.e., gel or wax-based, the desired rheology, the liquid base material used and the other materials to be used in the composition. The solidifying agent is preferably used in an amount from about 3% to about 20%. Solidifying agents includes ceresin, **ozokerite**, **white beeswax**, synthetic waxes, and **mixtures thereof**. The waxy materials may also serve as emollients. See column 8, lines 10-45. Additionally Vatter teaches an emollient as essential to the compositions. The emollient component aids in the

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application and adhesion of the composition to the skin and most importantly provides occlusive moisturization. Suitable oils include esters, triglycerides, hydrocarbons and silicones are used in the amount of 5% to about 90% and most preferably from about 70% to about 90% of the emollient component. Petrolatum is specifically taught. See column 5, lines 20-25, column 6, line 9, and column 6, lines 55-60.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to further add noni fruit juice to the lip balm composition disclosed by Morinda Inc. One would have been motivated to do so since Fisher teaches the use of noni juice has been used for many years to heal skin problems. Therefore, a skilled artisan would have been motivated to further utilize the juice extract to heal lip abrasions and wounds. It would have been further obvious to look to the teachings of Kondo and utilize the fruit juice in the instant amount since Kondo teaches the Morinda citrifolia plant extract is utilized in the amount of 0.0005-5% for external skin preparations including lipsticks.

It is noted that applicant has not provided the weight percent of each individual component in the lip balm; however it is the examiner's position that the weight percent of each component claimed would fall within the instantly claimed weight percent. However, assuming arguendo the ranges do not fall within the instant ranges, it would have been further obvious to look to the teachings of Vatter and utilize the instant concentrations. One would have been motivated to utilize ozokerite in the instant amount since acts as a solidifying agent to form a cosmetic stick. Further, one would have been motivated to utilize petrolatum in the instant amount for its advantages taught by Vatter which include providing adhesion of the composition to the skin and provides occlusive moisturization.

***Response to Arguments***

It should be noted that the lip balm introduced May 26, 2001 has a 102(a) date. If the reference is disclosing applicant's own work as derived from him or her, the applicant may submit either a 37 CFR 1.131 affidavit to antedate the reference or a 37 CFR 1.132 affidavit to show derivation of the reference subject matter from applicant and invention by applicant. See MPEP 2132.01.

**Claims 1, 7-8, 11-12, 22, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP2000-095663 to Kondo et al in view of Elkins (Hawaiian Noni, 1998) in further view of Vatter et al (6,224,888).**

JP teaches a plant extract such as *Morinda citrifolia* for external use. These plant extracts have various properties such as skin whitening abilities, antioxidants effects, and antimicrobial effects, which make them effective for external use. See abstract. The plant extract is utilized in the amount of 0.0005-5% and JP discloses the use of instant *Morinda citrifolia* in the amount of 4.8%. Note Table 2 and page 4 of the translation. The plant extract is extracted from the branch, trunk, bark, bloom, fruit (contains the juice), roots, or other dry matters. The fruit is exemplified. Note that the fruit contains the juice and the seed, which contains the oil. See page 3. The external applications taught are milky lotion, cream, a pack, foundation, **lipstick**, shampoo, and conditioner and in the form of a liquid, salve, gel, etc. See page 2 and examples. Kondo et al teach additives such as lower alcohols, polyhydric alcohols, oily components (paraffin, squalene, cetyl alcohol), antioxidants, surfactants, thickeners, astringents, UV absorbents (octyl methoxycinnamate), vitamins, etc. in the cosmetic compositions. See examples and page 4.

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Examples teach the squalene in the amount of 5% and octyl methoxycinnamate in the amount of 5%. It should be noted that linoleic acid and xeronine are inherent properties of *Morinda citrifolia*.

JP does not specify the part of the fruit utilized, i.e. the fruit seed oil or the fruit juice.

Further, the reference does not teach the instant ozokerite.

Elkins teaches the usage of noni for over hundreds of years for its therapeutic actions (antimicrobial, antioxidant, and emollient benefits). Elkins teaches that *all* parts of the noni plant such as the fruit, the seeds (which contains the oil), bark, leaves, and flowers are utilized. See page 9-11. One of the most prevalent uses of noni is as a skin healing agent due to the presence of proxeronine and the skin's response to it. See page 30.

Vatter teaches a cosmetic composition including skin care products that treat and care for the skin, i.e. moisturize or improve the condition of the skin. See column 2, lines 20-25. Further, Vatter teaches utilizing a "solidifying agent" that solidifies liquid base materials to be used in a cosmetic composition. This solidifying refers to the physical and/or chemical alteration of the liquid base material so as to form a solid or semi-solid at ambient conditions, i.e., to form a final composition which has a stable physical structure and is deposited on the skin during normal use conditions. The selection of the particular solidifying agent for use in the cosmetic compositions will depend upon the particular type of composition desired, i.e., gel or wax-based, the desired rheology, the liquid base material used and the other materials to be used in the composition. The solidifying agent is preferably used in an amount from about 3% to about 20%. Solidifying agents include ceresin, ozokerite, white beeswax, synthetic waxes, and mixtures thereof. The waxy materials may also serve as emollients. See column 8, lines 10-45. Additionally Vatter

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teaches an emollient as essential to the compositions. The emollient component aids in the application and adhesion of the composition to the skin and most importantly provides occlusive moisturization. Suitable oils include esters, triglycerides, hydrocarbons and silicones are used in the amount of 5% to about 90% and most preferably from about 70% to about 90% of the emollient component. Petrolatum is specifically taught. See column 5, lines 20-25, column 6, line 9, and column 6, lines 55-60.

Firstly, although Kondo does not specify the part of the *Morinda citrifolia* fruit utilized, it is would have been obvious to one of ordinary skill in the art to look to the guidance provided by Kondo and Hawaiian Noni and utilize any part of the *Morinda citrifolia* extract in the cosmetic composition, i.e. the fruit seed oil and fruit juice. It should be noted that the fruit contains both the juice and the seed which contains the oil. One would have been motivated to do so since JP teaches any part of the plant may be utilized and it will impart cosmetic benefits of skin whitening abilities, antioxidants effects, and antimicrobial effects. Hawaiian Noni also teaches that all the parts of the noni plant provide beneficial effects to the skin and have been used for years. Therefore, absent unexpected results, it would have been prima facie obvious for a skilled artisan to utilize all parts of the fruit in a composition and expect benefits to the skin.

Secondly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further look at the teachings of Vatter et al and utilize the instant ozokerite. One would have been motivated to do so with the expectation of success since Kondo teaches the composition may contain additional additives such as thickeners and oily components and Vatter teaches the use of wax hydrocarbon agents not only serve as emollients but also serve to change the rheology of the cosmetic composition to provide the desired structure to the



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cosmetic composition, i.e. a solid or semi-solid cosmetic. Therefore, it would have prima facie obvious to utilize the instant ozokerite in the cosmetic composition of Kondo for its dual purpose of serving as an emollient and its ability to change the physical structure of the composition to yield a desired structure, i.e. it acts as a thickener. Moreover, it would have been obvious to further utilize petrolatum in the composition for the advantages taught by Vatter which include providing adhesion of the composition to the skin and provides occlusive moisturization. Lastly, a skilled artisan would have expected success by the instant combination since both references are in the same field of endeavor, i.e. skin care products used to moisturize and care for the skin.

### ***Response to Arguments***

Applicant argues that applicant has amended the claims to include ozokerite to overcome the rejection.

Applicant's arguments filed 7/25/05 have been fully considered but they are not persuasive. The use of ozokerite in a cosmetic composition is considered to be obvious since it is a conventional additive in the cosmetic art. The examiner suggests that the applicant demonstrate the unexpectedness of the combination of the juice and oil in the instant weight ratio to overcome the obviousness rejection.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

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provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**Claims 1, 7-8, 11-12, and 27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 6,589,514 in view of Rattan (5,614,407). Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application and US patent claim similar subject matter with obvious modifications.**

Instant application claim 1 is directed to a composition containing 0.1-50% *Morinda citrifolia* juice, 0.1-20% *Morinda citrifolia* oil, and 5-20% ozokerite.

US '514 claim 1 is directed to a repair treatment comprising: 0.1-80% *Morinda citrifolia* juice and a sun-screening element wherein instantly claimed octyl salicylate and octyl methoxycinnamate are listed in the Markush group. Dependent claim 14 recites 0.1-10% *Morinda citrifolia* oil. The combination of claims 1 and 14 of US Patent yield a composition containing *Morinda citrifolia* juice, *Morinda citrifolia* oil, and octyl salicylate/ octyl methoxycinnamate. US '514 claim 59 is directed to a repair composition containing 0.1-80% *Morinda citrifolia* juice, an active ingredient, and 0.1-5% *Morinda citrifolia* oil.

US '514 does not claim instant ozokerite.

Rattan teaches method of ameliorating the adverse effects of aging with cytokinins as the active agent. Rattan teaches vehicles such as lotions conventionally contain 1-50% of an emollient such as hydrocarbons and waxes including petrolatum, ozokerite, paraffin, and ceresin. See column 15, lines 40-45.

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Firstly, it should be noted that the intended use of a composition is not given weight. Thus the fact that the instant claim is used for a lip treatment and '514 is an intensive serum for the skin is irrelevant since both claim composition that claim the critical ingredients *Morinda citrifolia* juice and *Morinda citrifolia* oil in overlapping weight percents. Secondly, US '514 has open claim language that may include other conventional additives such as instantly claimed ozokerite. Therefore, it would have been obvious to further include instantly claimed ozokerite in the composition of '514 and arrive at instantly claimed composition. One would have been motivated to do so since Rattan teaches cosmetic lotions commonly contain emollients such as ozokerite in the instant weight percent. Thus, a skilled artisan would have been motivated to add a conventional additive such as instant ozokerite for its emollient effects.

#### ***Response to Arguments***

The examiner acknowledges the Terminal Disclaimer filed by the applicant on 7/25/05; however the examiner notes that applicant has disclaimed US application 10/836869 and the instant rejection is over US 6,589,514. Accordingly the instant claims are still rejected under obviousness double patenting.

#### ***Conclusion***

None of the claims are allowed at this time.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharmila S. Gollamudi whose telephone number is 571-272-0614. The examiner can normally be reached on M-F (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on 571-272-0887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SSG

Sharmila S. Gollamudi  
Examiner  
Art Unit 1616



SREENI PADMANABHAN  
SUPERVISORY PATENT EXAMINER